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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,843	08/24/2001	Victor Spoke III	TREM.0001	1221
38327	7590	08/28/2006	EXAMINER	
REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			FISHER, MICHAEL J	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/935,843	<b>Applicant(s)</b> SPOKE ET AL.	
	<b>Examiner</b> Michael J. Fisher	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 6,810,359 to Sakaguchi in view of US PAT 6,687,634 to Borg.

As to claims 1,9,10 Sakaguchi discloses a computer implemented method (col 2, lines 25-26, brief description of fig 2) comprising diagnosing existing conditions of equipment (col 2, lines 62-65) to determine if any repairs are required to bring the equipment up to a predetermined standard (col 3, lines 8-11) negotiated between the owner and the provider (inherent in that the provider agrees to keep the equipment up to industry standards), repairing the equipment up to the standards (col 3, lines 12-15), developing a maintenance schedule to perform recurrent inspections (fig 2, inspections standards data), preventative maintenance (col 3, line 63-col 4, line 2), and

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housekeeping (col 3, lines 23-26). It would inherently be performed for a specified time (for as long as the owner of the equipment was paying for the service).

Sakaguchi does not, however, teach providing a warranty.

It is very well known in the art to provide service contracts to guarantee services rendered.

Borg discloses a method of monitoring and maintenance for products (title) that ensures that equipment is up to industry standards (26, 28,30,32,34) bringing the equipment up to those standards if they are not met (38) and using this for a service contract provider (col 5, lines 39-41). It would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Sakaguchi with the service contract as disclosed by Borg as Borg shows this to be a good way to ensure warranty compliance.

As to claim 2, Sakaguchi discloses inspecting the site where the equipment is located (col 3, lines 23-26, it would be inherent that the location was inspected as Sakaguchi discloses identifying places where dust or oil would be generated or leaked).

As to claim 3, Sakaguchi discloses interviewing the owner or manager of the equipment (inherent in that the owner or manager must be consulted prior to work is done on their equipment).

As to claim 4, Sakaguchi discloses generating a report on the results of the diagnosing step (fig 2).

As to claim 5, Sakaguchi discloses inputting and analyzing results (fig 2).

As to claim 6, Sakaguchi discloses recommending repairs (col 6, lines 40-49).

Sakaguchi does not, however, teach providing cost estimates. It is very well known in the art to provide cost estimates for prospective work. Therefore, it would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Sakaguchi in view of Borg by providing cost estimates so the owner of the equipment could evaluate if it is cost-effective to perform the work. For instance, if the cost estimate is more than the cost of replacing the equipment, it would not be cost-effective.

As to claim 7, Sakaguchi discloses adjusting the maintenance schedule in view of the inspection (col 7, line 17- col 8, line 25).

As to claim 8, Sakaguchi discloses a step of inputting results of the inspection step (col 7, lines 17-21).

As to claims 11,13,15, it would be obvious to one of ordinary skill in the art to transfer 100% of the risk as a warranty is known to transfer the risk from the owner.

As to claim 12,14,16, it is very well known to exclude these from warranty risks.

### ***Response to Arguments***

Applicant's arguments filed 3/27/06 have been fully considered but they are not persuasive. The affidavits as supplied have stated that transferring the risk was advantageous, implying that the process was not new, merely that the responsibility for it was transferred. Further, applicant has argued matter not in the claims but advantages with the system. The examiner does not disagree that the system is advantageous, but that it is not new. While commercial success can be a factor, there

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also must be an element in the success that shows that it is new, the affidavits as provided have not done so.

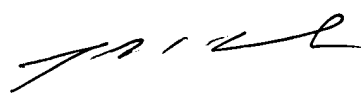
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Fisher whose telephone number is 571-272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

8/21/06

  
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